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REMARKS

The applicants have carefully considered the final Office action dated May 22, 2007. In view of the following remarks, it is respectfully submitted that all pending claims are in condition for allowance and reconsideration and allowance are respectfully requested.

The Finality of the Office Action is Premature

As an initial matter, the applicants respectfully submit that the finality of the Office action is premature because, as explained below, the Office action presents new grounds for the rejection that were not necessitated by applicants' amendments of the claims nor based on information submitted in an information disclosure statement.

> Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

MPEP § 706.07(a). (emphasis added)

First, all of the amendments to the claims made in response to the previous non-final Office action were either clarifying amendments or were based on recitations found in dependent claims (e.g., see claim 1, which was amended to include the recitations of dependent claims 6 and 12 and thus recites the Original scope of claim 12). Regardless of the form of amendments, the arguments presented by the examiner with respect to the newly cited art indicate that the newly cited art was needed to allegedly support the rejection of the recitations Originally found in dependent claims. In particular, the Office action uses only the newly cited art when providing alleged support for rejecting the recitation: tracking a list of recorded

programs for duplicates when a record operation is initiated, and activating a preference to erase a recording of a program that is identified as a duplicate. A brief review of the Examiner's Search Strategy of April 27, 2007, and the Search Notes of May 22, 2007, supports this premise by evincing that the examiner was searching for prior art describing activating a preference to erase a duplicate recording of a program recitations, recitations previously found, for example, in claims 6 and 12.

Second, the references first cited in the Office action dated May 22, 2007, were not listed in the information disclosure statement filed by the applicants on February 16, 2007.

In summary, the new grounds of rejection were not necessitated by the applicants' amendments because the scope of the independent claims was present in at least dependent claim 12. Nor was the new ground of rejection based on references submitted by the applicants. Therefore, the finality of the rejection is premature. Accordingly, the applicants respectfully request that the finality of the action be withdrawn in accordance with MPEP § 706.07(d).

The Pending Claims are Allowable

Turning to the rejections in the Final Office action, independent claims 1 and 56 were rejected as unpatentable over Vallone et al. (US 6,847,778) in view of Liebenow (US 6,601,074) and Browne et al. (WO 92/22983), Browne in view of Liebenow, and Wood et al. (US Pub. No. 2002/0054752) in view of Liebenow and Browne. A brief review of the rejections reveals that a combination of Liebenow and Browne is used to allegedly describe the following recitations from claims 1 and 56: tracking a list of recorded programs for duplicates when a record operation is initiated, and activating a preference to erase a recording of a program that is

identified as a duplicate. As explained below, the combination of Liebenow and Browne is deficient and reconsideration of the rejection is respectfully requested.

Liebenow is directed to episode identification in an electronic program guide in conjunction with a recording device. In particular, Liebenow describes determining, before a program to be recorded begins, whether or not the program has been previously recorded. (Liebenow, 5:27-31). Liebenow describes that a decision whether or not to record the program is made based on the determination as to whether the program was previously-recorded. (Liebenow, 5:58-59). In one implementation, Liebenow describes that a program will not be recorded if the program has been previously recorded. (Liebenow, 5:58-6:3). In the alternate implementation, Liebenow describes that a second copy of a program is recorded if the second copy can be recorded with a higher quality than a previously recorded copy. (Liebenow, 6:22-24). Liebenow does not describe or suggest deleting any previously-recorded programs nor suggest that such deletion may be desirable or even feasible using the suggested recording media. In fact, Liebenow describes intentionally creating duplicates of programs:

> record a second copy of a program, if the second copy can be recorded with a higher quality than the previous copy. (Liebenow, 6:22-24)
>
> As an example, suppose that a user records a particular episode of a program on a VCR tape. The user subsequently purchases a DVD recorder/player. If the previously recorded episode airs again, a preferred method according to the present invention will record the episode on DVD, since the quality of the recording can be increased by using a higher quality recording medium. Alternatively, a program stored on a VCR tape from a standard broadcast program will be recorded again, if the program later becomes available for recording from a DVD, because the quality of the recording can be increased by recording from a higher quality source. (Liebenow, 6:27-47)

In other words, Liebenow describes selective recording based on certain criteria (i.e., the presence of a duplicate recording and the quality of the duplicate recording compared to the quality of the current recording).

Browne is directed to a large capacity, random access, multi-source recorded player. Browne describes a preference menu allowing a user to establish a preference for deleting the oldest recorded program, the oldest viewed program, or programs selected by a user of the player (Browne: FIG. 3, block 301). The portions of Browne cited in the Office action do not describe or suggest deleting a program that is identified as a duplicate.

The Office action alleges that it would have been obvious to modify Vallone in view of Liebenow and Browne to include tracking a list of recorded programs for duplicates and activating a preference to erase a recording of a program that is identified as a duplicate in order to manage storage by deleting unnecessary data. However, it is not clear how this motivation is supported by the cited references. Browne does not describe the occurrence of, nor handling of duplicates. Further, while Browne suggests deleting the oldest programs, the oldest viewed programs, or selected programs, Browne does not indicate that these programs are somehow unnecessary data. Rather, Browne indicates that the erasure selection is merely a way for a user to manage how stored programs will be saved. (Browne, page 18:33-page 19:2).

Thus, the motivation suggested by the Office action must be found in Liebenow. However, Liebenow fails to describe or suggest that duplicates are unnecessary data. In fact, Liebenow even describes the intentional creation of duplicate recordings. (Liebenow, 6:19-47). In other words, while Liebenow

describes the creation of duplicates, Liebenow does not describe or suggest that the created duplicates are somehow unnecessary or should be removed from the system.

Even if Liebenow and Browne together described all of the recitations of claims 1 and 56, the motivation for combination alleged in the Office action is not supported by the citations to Liebenow and Browne. Rather, the applicants respectfully submit that the motivation is based on the applicants' own disclosure that suggests that the deletion of duplicates is desirable. When making obviousness rejections, the references used must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention. See *Hodosh v. Block Drug Co.*, Inc, 229 U.S.P.Q. 182, 187 n.5 (Fed. Cir. 1986). "Impermissible hindsight must be avoided and the legal conclusion [of obviousness] must be reached on the basis of the facts gleaned from the prior art." MPEP § 2142.

Accordingly, because Liebenow and Browne are the sole references used to support the rejection of the aforementioned recitations of claim 1 and 56 and Liebenow and Browne are deficient in that regard, each of the three rejections of claims 1 and 56 under 35 U.S.C. § 103 are deficient. Accordingly, claims 1, 56, and all claims depending therefrom are in condition for allowance and reconsideration thereof is respectfully requested.

If, for any reason, the examiner is unable to allow the application in the next Office action, the examiner is encouraged to telephone the undersigned attorney at the telephone number listed below.

Respectfully submitted,

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